

REMARKS

Prior to entry of this amendment, Claims 1-25 were pending in this application. By this amendment, Claims 1-3, 6, 8-14, 16-21 and 24-25 have been amended. The amendments to the claims do not require a new search of the prior art because the claim amendments were made merely to use more consistent terminology throughout the claims and clarify features that were disclosed and claimed in the application as originally filed. No new claims are added and no claims are cancelled.

Claims 1-25 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Pat. No. 6,470,389 to Chung et al. ("*Chung*") in view of U.S. Pat. No. 6,067,620 to Holden et al. ("*Holden*").

The rejection is herein respectfully traversed.

Independent claims 1, 6, 10, 14, 18 and 22

Representative independent method claim 1, as amended, requires the steps of:

receiving a first request for a service from the host by the first server, which request includes a network address of the host;

comparing a network address of the first server to a network address of the second server to determine if the network address of the first server is identical to the network address of the second server; and

if the network address of the first server is determined to be identical to the network address of the second server, communicating a second service request from the first server to the second server when the first service request includes functions not available in the first server, said second service request including the host network address.

The cited prior art references do not teach or suggest every element of these steps.

Independent claims 1, 6, 10, 14, 18 and 22 recite servers that *communicate with each other* in order to respond to client requests. For example, as described in the present specification at page 3, lines 7-16, and shown in Fig. 1B, proxy server 1108 receives requests from clients 1112A and 1112B, and send requests to application server 1106 over logical path 1110. Significantly, proxy server 1108 *communicates* requests to application server 1106.

The Office Action asserts that “server 1” of *Chung* teaches a first server, and “server 2” of *Chung* teaches a second server cooperating with the first server to respond to a request from a host as required by claim 1 of the present invention. (Office Action, page 2, paragraph 4.) The Office Action asserts that Col. 3, line 65 – Col. 4, line 63 of *Chung* teaches the step of “communicating a second service request from the first server to the second server when the first service request includes functions not available in the first server” as *Chung* teaches that “the address of two servers can be identical when the two servers are in a cluster.”

However, *Chung* never discloses or suggests that server 1 and server 2 communicate in any way, much less that the first server (server 1) communicates a service request to the second server (server 2), as provided in the claims. Server 1 and server 2 in *Chung* are merely servers in a server cluster. A service request is communicated to either server 1 or server 2 through router 32 (Col. 2, lines 58-62) or dispatcher 64 (Col. 4, lines 5-54). Server 1 never communicates a request to server 2.

Furthermore, *Chung* teaches away from Claim 1. Col. 4, lns 6-7 and Col. 4, lns 36-37 of *Chung* teach that the dispatching mechanism disclosed in *Chung* “is used to ensure that each client request is processed by only one server in the cluster.” In *Chung*, a router or dispatcher is used to dispatch service requests to a **single** server in a server cluster. In Claim 1, a **first server** receives a request, and if the request includes functions not available on the first server, **the first server communicates a request to a second server** for processing. Rather than attempting to ensure that a client request is processed by only one server as in *Chung*, the present claims recite that a second request is communicated to the second server from the first server if the request includes functions not available on the first server.

The Office Action asserts that “server 1” and “server 2” in *Chung* read on the first and second server, respectively, required by the claimed invention. As discussed above, server 1 and server 2 clearly do not communicate, and therefore cannot anticipate the claimed invention.

Moreover, claim 1 recites “comparing a network address of the first server to a network address of the second server to determine if the network address of the first server is identical to the network address of the second sever” and “if the network address of the first server is determined to be identical to the network address of the second server, communicating a second service request from the first server to the second server.” Although server 1 and server 2 may have identical addresses, as discussed above server 1 never communicates with server 2, and therefore cannot anticipate this limitation of claim 1. In addition, the network address of server 1 is never actually **compared** to the network address of server 2.

In addition, neither the router nor the dispatcher in *Chung* can be used to read on the first server. The network address of the router/dispatcher is never compared to the network address of a server in the server cluster. Even if the addresses were compared, routers and dispatchers do not have the same network address as any server in the server cluster, and therefore cannot anticipate this claimed feature. *Chung* teaches at Col. 2, lns 53-61, that a client uses the address RA of router 32 as a destination IP address in its request such that the request is directed to router 32. Router 32 then performs a “dispatching function by changing the destination IP address of each incoming IP packet of a given client request from the router RA address to the address Sk of selected server 14-k.” *Chung* also teaches that a router may direct client requests to a dispatcher, and the dispatcher selects a particular server to process a given client request based on the result of applying a hash function to the client address.

Although claims 1 and 6 have been amended herein to clarify that it is the first server (or proxy server) that sends a service request to the second server, independent claims 10, 14, 18 and

22 included the step of “sending the network address of the client from the first server to the second server in a secure request message” in their original form. Therefore, the claim amendments to claims 1 and 6 do not include any new matter and do not require a new search.

Likewise, claims 1 and 6 were amended to clarify that the network address of the first server is compared to the network address of the second server. Independent claims 10, 14, 18 and 22 included the step of “determining whether a first network address of the first sever is equal to a second network address of the second server” in their original form, and therefore the claim amendments to claims 1 and 6 do not include any new matter or require that a new search be performed.

Accordingly, it is respectfully submitted that independent claims 1, 6, 10, 14, 18 and 22 are patentable over the cited art and in condition for allowance.

Dependent claims 2-5, 7-9, 11-13, 15-17, 19-21 and 23-25

Claims 2-5, 7-9, 11-13, 15-17, 19-21, and 23-25 are dependent claims, each of which depends (directly or indirectly) on one of the independent claims, and is therefore allowable for the reasons given above for the claim on which it depends. In addition, each of the dependent claims introduces one or more additional limitations that independently render it patentable. In view of the patentability of the independent claims, only some of the dependent claims are further argued at this time to expedite prosecution.

Claims 2, 7, 11, 15, 19 and 23

The Office Action admits that neither *Chung* nor *Holden* discloses that the request comprises a key value comprising an originating host IP address and a random value. The Office Action asserts that “these features are well known in the art and would have been an obvious modification to one having ordinary skill in the art at the time of the invention because it enhances the security of the system.” (Office Action Page 3, paragraph 5.)

However, this feature facilitates identifying separate browsers running on the same computer, as shown in Fig. 1A and described in the present specification at Page 2, line 14 – Page 3, line 5. As IP addresses are associated with specific client hardware such as workstations or personal computers, “random values 1142A, 1142B are used to uniquely identify more than one instance of a browser running on the same physical machine.” The motivation cited in the Office Action of “enhancing the security of the system” would not motivate one skilled in the art to include a key value for a request that comprises an originating IP address and a random value.

Moreover, an obviousness rejection is not appropriate if substantial reconstruction or redesign of the prior art references is necessary to arrive at the claimed invention, as is the case with the cited references, with respect to Claims 2, 7, 11, 15, 19 and 23. (See In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). None of the cited references convey or suggest a client request that includes a key value comprised of an originating IP address and a random value. The system of *Chung* would have to be substantially redesigned in order to provide for such inclusion.

For example, *Chung* teaches at Col. 4, lns 50-55, that “the dispatcher selects a particular one of the servers to process a given client request based on the result of applying a hash function to the client address.” If a key value comprised of an originating IP address and a random value is used in the session data to identify a request, the system in *Chung* would have to be substantially reconstructed. *Chung* would have to be modified to perform a hash function on both the originating IP address and the random value in the key value, or to extract the originating IP address from the stored session data.

In addition, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purposes, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed Cir. 1984)

Here, the addition of a key value that includes a random value in the client request would needlessly increase the cost and complexity of the system in *Chung*, as there is no suggestion or motivation to include a key value in the client request, and may make it impossible for dispatcher in the system in *Chung* to properly route client requests.

Finally, the Federal Circuit has recently reiterated that “there must be some form of evidence in the record to support an assertion of common knowledge.” See *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ 2d 1430, 1434-35 (Fed. Cir. 2002); *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ 2d 1693, 1697 (Fed. Cir. 2001) (holding that general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection; and that conclusory statements when dealing with particular combinations of prior art and specific claims cannot be used, and that a rationale must be set forth).

Guided by the foregoing principles, the Office Action statement that “these features were well known in the art and would have been an obvious modification to one of ordinary skill in the art at the time of the invention because it enhances the security of the system” does not meet the standard for an obviousness rejection under 35 U.S.C. § 103. The stated goals are so general and vague that they cannot rationalize the specific invention that is claimed. It is well-settled that “[i]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious” (*In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992); quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)). It appears that impermissible hindsight was used to generate the foregoing statement of motivation.

For the foregoing reasons, Applicants respectfully request the withdrawal of the rejection of claims 2, 7, 11, 15, 19 and 23.

Conclusion

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. Please charge any shortages in fees to Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



Lesley Coulson Boveri
Reg. No. 46,642

Dated: September 14, 2004

1600 Willow Street
San Jose, California 95125-5106
Telephone No.: (408) 414-1080
Facsimile No.: (408) 414-1076

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

on September 14, 2004

by

